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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,826	03/04/2002	Shizu Hosono	Q67676	2931

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EXAMINER
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CHO, UN C

ART UNIT	PAPER NUMBER
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2687

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/086,826

Applicant(s)

HOSONO, SHIZU

Examiner

Un C. Cho

Art Unit

2687

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,6,10,15,16,23,28,29,36,41 and 42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,5,7-9,11-14,17-22,24-27,30-35,37-40 and 43-48 is/are rejected.
- 7) ☒ Claim(s) 42 and 49-56 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/9/2005</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/15/2005 has been entered.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 8/9/2005 has been placed in record and considered by the examiner.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 14, 27 and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 1, 14, 27 and 40 recite the limitation "the base station" in each of its claim.

There is insufficient antecedent basis for this limitation in the claim.

***Claim Objections***

6. Claim 42 is objected to because of the following informalities:

Regarding claim 42, the claim recites "The position search method as claimed in claim 40, wherein said method further comprises" and the rest of the claim limitation has been crossed out.

It seems as if claim 42 should have been a canceled claim.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 4, 5, 7, 9, 11 – 14, 17 – 20, 22, 24 – 27, 30 – 33, 35, 37 – 40, 43 – 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Irvin (US 6,768,909 B1) in view of Smith (US 2002/0042277 A1).

Regarding claim 1, Irvin discloses a radio apparatus comprising:  
positioning means for determining a position of said radio apparatus (GPS receiver, Fig. 3a, 210); receiving means for receiving a radio signal (transceiver, Fig. 3a, 44); judging means for judging whether said apparatus can determine its position (mobile terminal position controller (Fig. 3a, 38) determines whether its internal GPS receiver has failed; Irvin, Col. 10, lines 7 – 13).

However, Irvin as applied above does not specifically disclose checking means for checking whether said radio signal includes a search request requesting the position of said radio apparatus; sending means for sending a message to a sender of said radio signal in response to said search request if said judging means judges that said apparatus cannot determine its position; wherein said message comprises the position of the base station located nearest to said radio apparatus. In an analogous art, Smith discloses checking means for checking whether said radio signal includes a search request requesting the position of said radio apparatus (MSC recognizes that MS1 sent a radio signal including \*LOC and the directory number for MS2, which means that MS1 wants to locate MS2; Smith, Page 2, Paragraph 0024, line 1 through Paragraph 0025, line 6 and see Fig. 4); sending means for sending a message to a sender of said radio signal in response to said search request if said judging means judges that said apparatus cannot determine its position; wherein said message comprises the position of the base station located nearest to said radio apparatus (if the system determines that MS2 has not registered within a period of time or is turned off, thus, not being able to give the current position, then it will return information to the requester (MS1) of the last registered cell ID information; Smith, Page 3 Paragraph 0028 line 1 through Paragraph 0031, line 9 and see EXAMPLE on Paragraph 0034, line 1 through paragraph 0035, line 15). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the technique of Smith to the system of

Irving in order to provide an efficient location monitoring system that locates the current position of a user (if active) or the last registered location (if inactive) so that the requester can always have an idea of where the user is located at all times.

Regarding claim 4, Irvin in view of Smith as applied above discloses storing means for storing said message (HLR stores location information of MS2; Smith, Page 2, Paragraph 0024, line 1 through Paragraph 0025, line 6).

Regarding claim 5, Irvin in view of Smith as applied above discloses sending said message even if said radio apparatus can determine its position (MS1 receives the current position of MS2 every time MS1 requests it; Smith, Page 3, Paragraph 0034, line 1 through paragraph 0035, line 15).

Regarding claim 7, Irvin in view of Smith as applied above discloses wherein said message indicates that said radio apparatus cannot determine its position (mobile terminal position controller (Fig. 3a, 38) determines whether its internal GPS receiver has failed and sends an instruction message; Irvin, Col. 10, lines 7 – 21).

Regarding claim 9, Irvin in view of Smith as applied above discloses positioning means for determining the position of said radio apparatus (GPS receiver; Irvin, Col. 5, lines 11 – 25); wherein said storing means stores radio apparatus position at a time when said radio apparatus can determine its position; and wherein said message comprises the latest radio apparatus position stored in said storing means (HLR always keeps track and stores

location information of MS2 at all time; Smith, Page 2, Paragraph 0024, line 1 through Paragraph 0025, line 6 and MS1 receives the current position of MS2 from the information retrieved from HLR; Smith, Page 3, Paragraph 0028, line 1 through Paragraph 0031, line 9).

Regarding claim 11, Irvin in view of Smith as applied above discloses wherein said radio apparatus is a portable telephone (Irvin, Col. 5, lines 11 – 25).

Regarding claim 12, Irvin in view of Smith as applied above discloses wherein said radio apparatus receives radio signals from a plurality of senders, and said storing means stores a message for each one of the plurality of senders (Smith, Page 1, Paragraph 0007, lines 1 – 18).

Regarding claim 13, Irvin in view of Smith as applied above discloses wherein at least one message stored in said storing means is different from another message stored in said storing means (the requesting subscriber may request information for a plurality of mobile subscribers that are identified in an information profile; Smith, Paragraph 0007, lines 16 – 18).

Regarding claims 14, 27 and 40, the claims are interpreted and rejected for the same reason as set forth in claim 1.

Regarding claims 17, 30 and 43, the claims are interpreted and rejected for the same reason as set forth in claim 4.

Regarding claims 18, 31 and 44, the claims are interpreted and rejected for the same reason as set forth in claim 5.

Regarding claims 19, 32 and 45, the claims are interpreted and rejected for the same reason as set forth in claim 6.

Regarding claims 20 and 33, the claims are interpreted and rejected for the same reason as set forth in claim 7.

Regarding claims 22 and 35, the claims are interpreted and rejected for the same reason as set forth in claim 9.

Regarding claims 24, 37 and 46, the claims are interpreted and rejected for the same reason as set forth in claim 11.

Regarding claims 25, 38 and 47, the claims are interpreted and rejected for the same reason as set forth in claim 12.

Regarding claims 26, 39 and 48, the claims are interpreted and rejected for the same reason as set forth in claim 13.

9. Claims 8, 21 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Irvin in view of Smith as applied to claim 3 above, and further in view of Havinis (US 6,311,069 B1).

Regarding claim 8, Irvin in view of Smith as applied above does not specifically disclose wherein said message indicates that said radio apparatus rejects said request for its position. In an analogous art, Havinis discloses wherein said message indicates that said radio apparatus rejects said request for its position (Havinis, Col. 6, lines 14 – 22). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the

technique of Havinis to the modified system of Irvin in view of Smith in order to provide a system that enhances and secures the privacy of the mobile subscriber by notifying to the mobile subscriber when is being positioned.

Regarding claims 21 and 34, the claims are interpreted and rejected for the same reason as set forth in claim 8.

***Allowable Subject Matter***

10. Claims 49 – 56 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 49, Irvin, Smith and Havinis either alone or in combination fails to teach setting means for setting a response hold state if said judging means determines that said radio apparatus cannot determine its position; identification means for checking the identification of the sender of said radio signal after said response hold state is set; and reading means for reading the message stored in said storing means after said response hold state is set; wherein after said message is read from said storing means, said response hold state ends and said sending means sends said message.

Regarding claims 51, 53 and 55, the claims is interpreted and objected for the same reason as set forth in claim 49.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Un C. Cho whose telephone number is (571) 272-7919. The examiner can normally be reached on M ~ F 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on (571) 272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Un C Cho  
Examiner  
Art Unit 2687

2/3/06 *UC*

*U. R. J.*  
**ELISEO RAMOS-FELICIANO**  
**PATENT EXAMINER**